



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LAML3003/JEK/JJC

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Typed or printed name \_\_\_\_\_

Application Number

09/486,723

Filed

May 18, 2000

First Named Inventor

Michael LAMLA et al.

Art Unit

2135

Examiner

Odaiche T. AKPATI

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☐ attorney or agent of record.  
Registration number \_\_\_\_\_

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 46,205

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July 26, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re Application of:**

**Inventor:** Michael LAMLA et al.

**Attorney No.:** LAML3003/JEK/JJC

**Application No.:** 09/486,723

**Customer No.:** 23364

**Filed:** May 18, 2000

**Confirmation No:** 2431

**Examiner:** Odaiche T. AKPATI

**Art Unit:** 2135

**For:** METHOD FOR TESTING THE AUTHENTICITY OF A DATA  
CARRIER

**ARGUMENTS IN FAVOR OF PRE-APPEAL BRIEF CONFERENCE**

**MAIL STOP AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

**INTRODUCTORY COMMENTS**

This paper accompanies the PRE-APPEAL BRIEF REQUEST FOR REVIEW, and includes arguments in support for the pre-appeal brief conference and allowance of the pending claims. These arguments are in response to the Office action dated April 27, 2005. A Notice of Appeal is submitted herewith with the appropriate fee.

### ARGUMENTS

The sole rejection that will be addressed in an appeal brief is the rejection of pending independent claims 1, 8, 12 and 14 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,878,142 (Caputo et al.). Claims 1 and 8 relate to a method for testing the authenticity of a data carrier, claim 12 relates to a data carrier, and claim 14 relates to a system for testing the authenticity of a data carrier. The independent claims share the same inventive features that are distinguishable over the teachings of the Caputo patent.

The arguments in support for the pre-appeal brief conference and allowance of the pending claims are simple and can be summarized as follows:

1. The Caputo patent fails to disclose or suggest the feature of authenticating a data carrier with an external device wherein first and second transmission channels or devices arranged to generate first and second signals are provided for both the data carrier and external device which exchange signals between corresponding first and second transmission channels.
2. The Caputo patent fails to disclose or suggest the first and second transmission channels or devices of the data carrier and the external device as being logically separated from one another.
3. The Caputo patent fails to disclose or suggest the feature of the second transmission channel or device as being activable during the total time period between activation and deactivation of the data carrier.

4. The Caputo patent fails to disclose or suggest the feature of transmitting a signal for authenticity at least partly over the second transmission channel or device.

Concerning the first argument, it is clear that the Caputo patent does not disclose the feature of authenticating a data carrier with an external device wherein first and second transmission channels or devices arranged to generate first and second signals are provided for both the data carrier and external device which exchange signals between corresponding first and second transmission channels. This is evident in view of the encrypting/authenticating device embodiments of both Figs. 1A and 1B of the Caputo patent which are plainly described as communicating with two different external devices.

Specifically, the device of Fig. 1A is disclosed as communicating with both a personal computer or terminal, and a telephone system (col. 4, lines 55-59). Alternatively, Fig. 1B is discussed as similarly communicating with both a personal computer or terminal, and a telephone system (col. 4, line 66 through col. 5, line 6). There are no other embodiments in the Caputo patent which provide alternate embodiments other than the embodiment of Fig. 1C which is merely the combination of a smartcard and a device which operate cooperatively as the device referred to in both Figs. 1A and 1B (col. 5, lines 7-10).

In the action, it is asserted that because pending claims 1 and 8 are drafted in open form using the term "comprising," these claims include all of the limitations and more. It is not understood, however, how the specific language in both claims 1 and 8 which recite an external device in the singular form and without any reference to such external device as being in plurality can be equated as the two distinct different devices of the computer and telephone system of the Caputo patent.

It is submitted that the Caputo patent simply does not disclose or suggest a data carrier that communicates with "an" external device, such that first and second

transmission channels or devices of both the data carrier and external device communicate with one another, as required by pending claims 1, 8, 12 and 14.

The remaining arguments flow from the deficiencies of the Caputo patent, as identified in the first argument. Concerning specifically the second argument, since the Caputo patent does not disclose a data carrier and an external device that have first and second transmission channels or devices which communicate with one another, it cannot teach these channels or devices as being logically separated from one another.

Additionally, the third argument is supported by the observation that since the Caputo patent does not disclose a data carrier and an external device having such first and second transmission channels or devices, it cannot disclose or suggest the feature of the second transmission channel or device as being activable during the total time period between activation and deactivation of the data carrier. Similarly, the Caputo patent cannot teach the feature of transmitting a signal for authenticity at least partly over the second transmission channel or device.

For these arguments, it is submitted that pending claims 1, 8, 12 and 14 are patentable over the Caputo patent, and allowance of all of the pending claims is respectfully requested on a review of the aforementioned arguments.

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Respectfully submitted,



Date: July 26, 2005

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